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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/658,135

09/08/2003

Harold M. Aznoian

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EXAMINER

KASZTEJNA, MATTHEW JOHN

ART UNIT

PAPER NUMBER

3739

MAIL DATE

DELIVERY MODE

01/22/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/658,135

Applicant(s)

AZNOIAN ET AL.

Examiner

Matthew J. Kasztejna

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 September 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2-9 and 12-21 is/are pending in the application.
- 4a) Of the above claim(s) 10, 11, 22 and 23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-9 and 12-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 February 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election of Species A, claims 2-9 and 12-21 in the reply filed on September 25, 2007 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

### ***Notice of Amendment***

In response to the amendment filed on February 27, 2007, amended claims 1 and 12 are acknowledged. The following new grounds of rejection are set forth:

### ***Claim Objections***

Claim 2 and 12 are objected to because of the following informalities: the word therethrough is misspelled in both of the claims as therethough. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear how the treatment accessory, which according to claims 2 and 12, is non-detachable and integrated at the distal end of the shaft is also *mounted* over a reduced diameter portion of the endoscope according to claims 3 and 15 respectively. The word mount means, to attach to or fix on or in a

support, backing, setting, etc. (see <http://dictionary.reference.com/browse/mount>).

Meaning that the treatment accessory recited in claims 3 and 15 is attached to or fixed onto a reduced diameter portion of the endoscope, which is contrary to the limitations of a non-detachable integrated accessory of the independent claims. Thus, claims 3 and 15 and dependent claims 4-5 and 16-17 thereof, are rejected.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 2-4, 6 and 12-16 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,947,983 to Solar et al.

**In regards to claims 2-3 and 12-15**, Solar et al. an endoscope and comprising: an endoscope shaft having: proximal and distal ends; one or more uninterrupted lumens extending therethrough (see Figs. 1a-b and 3); a non-detachable treatment accessory integrated at the distal end of the shaft, wherein the treatment accessory further comprises a tissue apposition device comprising at least one suction port 11, 121, 131 and at least one needle 140 longitudinally slidable through the accessory to penetrate tissue 211 aspirated into the suction port (see Figs. 2a-e); non-detachable housing 110 for the accessory integrated into the endoscope shaft; one or more accessory control elements extending through the length of the endoscope; an accessory control

mechanism mounted at the proximal end of the endoscope (see Col. 3, Line 50 – Col. 4, Line 42).

**In regards to claims 4, 6, 16 and 18**, Solar et al. an endoscope wherein the cylindrical cartridge further comprises a side suction port and at least one tissue capturing means that is advanced through captured tissue along a circumferential path that rotates about a longitudinal axis of the endoscope and wherein the treatment accessory comprises a tissue-suturing device having at least one suction port and vacuum chamber and a semi-circular needle configured to be advanced in a circular path that traverses the vacuum chamber and tissue aspirated therein (see Figs. 1c, 2d and 3 and Col. 4, Lines 1-15).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-3, 7-9, 12-15 and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Application Publication No. 2003/0208209 to Gambale et al.

**In regards to claims 2-3, 9, 12-15 and 21**, Gambale et al. disclose an endoscope and comprising: an endoscope shaft having: proximal and distal ends; one or more uninterrupted lumens extending therethrough; a treatment accessory integrated at the distal end of the shaft, wherein the treatment accessory further comprises a tissue apposition device 50 comprising at least one suction port 86 and at least one

needle 80 longitudinally slidable through the accessory to penetrate tissue aspirated into the suction port (see Figs. 6); one or more accessory control elements extending through the length of the endoscope; an accessory control mechanism mounted at the proximal end of the endoscope(see paragraph 0103). Gambale et al. discloses the claimed invention except that the medical treatment accessory and the endoscope are integrated. It would have been obvious to one having ordinary skill in the art at the time the invention was made to integrat the treatment accessory to the distal end of the endoscope shaft, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893).

**In regards to claims 7-8 and 19-20**, Gambale et al. disclose an integrated endoscope and medical treatment accessory, wherein the treatment accessory further comprises a tissue apposition device having at least one suction port and vacuum chamber having a bottom surface and an optical viewing port and air and water port are present on the bottom surface (see paragraphs 0012 and 0102-105).

Claims 5 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,947,983 to Solar et al. in view of U.S. Patent No. 6,626,930 to Allen et al.

**In regards to claims 5 and 17**, Solar et al. an endoscope and comprising: an endoscope shaft having: proximal and distal ends; one or more uninterrupted lumens extending therethrough (see Figs. 1a-b and 3); a non-detachable treatment accessory integrated at the distal end of the shaft, wherein the treatment accessory further

comprises a tissue apposition device comprising at least one suction port 11, 121, 131 and at least one needle 140 longitudinally slidable through the accessory to penetrate tissue 211 aspirated into the suction port (see Figs. 2a-e); non-detachable housing 110 for the accessory integrated into the endoscope shaft; one or more accessory control elements extending through the length of the endoscope; an accessory control mechanism mounted at the proximal end of the endoscope (see Col. 3, Line 50 – Col. 4, Line 42). Solar et al. are silent with respect to wherein the suction port further comprises a partition wall that forces aspirated tissue to form into two separate tissue mounds. Allen et al. teach of an analogous apparatus having a pair of distally-directed tissue separating walls 44 extending therefrom, and defining a gap 46 therebetween (see Figs. 3a-e). It would have been obvious to one skilled in the art at the time the invention was made to include a tissue dividing wall in the apparatus of Solar et al. to have greater control over the tissue entering the vacuum ports as taught by Allen et al.

### ***Response to Arguments***

Applicant's arguments with respect to claims 2-9 and 12-21 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Kasztejna whose telephone number is (571) 272-6086. The examiner can normally be reached on Mon-Fri, 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



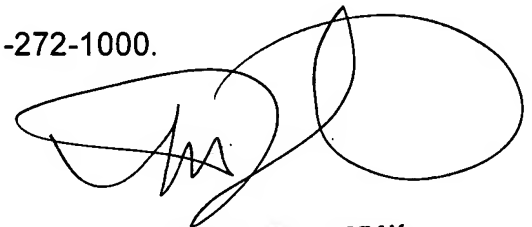
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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MJK *[signature]*

1/14/08



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